

material, which can be used to cut along other than a straight line, and which, preferably, may be used freely (i.e., is "freely movable" without restriction in both linear and non-linear directions) over the entire area of the sheet of material. Prior to the present invention, conventional cutting apparatus could only be utilized for cutting sheets to pre-determined sizes and in a straight line. For cutting sheet material, whether it be paper or cloth, etc., in other than a straight line, the craftsman would be required to use scissors or shears for a free-hand, non-linear cutting procedure.

The foregoing and related objects are achieved by the apparatus of the present invention for cutting sheet material, which includes a unit freely movable in both linear and non-linear paths, which has a lower part defining a sheet support surface for placement of a piece of sheet material, and an upper part defining an upper surface and disposed above said lower part with a gap existing between said upper part and said lower part for receiving the piece of sheet material. A cutting blade is secured in the upper and lower parts, and extends across said gap. The sheet support surface and the upper surface extend to either side of the cutting blade. Pressure means is mounted on the upper part in the gap for bearing on the piece of sheet material supported by the lower part adjacent to the cutting blade, so that the piece of sheet material is able to be inserted

between the pressure means and the sheet support surface for tensioning the piece of sheet material in the vicinity of the cutting blade.

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel and efficient apparatus for cutting sheet material in both linear and non-linear paths either disclosed or suggested.

By the present amendment, Applicant has amended independent Claim 20 (and Claims 21-24 via dependency) to expressly recite that the sheet cutting unit of the present invention, unlike the prior art of record, is "freely movable" and, therefore, capable of moving, and therefore cutting, in both linear and non-linear paths.

In the third Office Action, the Examiner declined to give the phrase "capable of freely moving," which described the potential movement for cutting as being in both linear and non-linear directions, patentable weight. The Examiner's refusal to provide such terminology its proper patentable weight is without legal merit.

The Examiner cited to In re Hutchinson, 69 USPQ 138 (C.C.P.A. 1946), for support for his contended legal position that "capable of" performing a particular function in an article or apparatus claim is not entitled to patentable weight. Hutchinson holds that the phrase "adapted" for use in

making an article "does not constitute a limitation in any patentable sense." *Id.* at 141. *Hutchinson* does not pertain to the phrase "capable of" in an article/apparatus, nor does it concern any article or apparatus claim limitation ending in the suffix *-able*, which is grammatically equivalent to an adverb modified by the phrase "capable of." In short, *Hutchinson* is irrelevant!

To recite in a patent claim that an article or apparatus is "capable of" performing a function is to recite a structural limitation in that claim, such as the recited structure may - as opposed to "may not" - perform the given function. A structure unable to, or "incapable of," performing the recited function cannot be structurally the same as one so capable. Such is the law, and has been the law, and nothing in *Hutchinson* holds to the contrary. A recitation that states what an article or apparatus can do is a limitation on the structure recited in the claim and is properly accorded patentable weight under the law.

More recently, in *C.R. Bard Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 48 USPQ2d 1225, 1229-1230 (Fed. Cir. 1998), the Federal Circuit construed the scope of a claim drawn to a biopsy needle, which included the term "freely slidable," as part of the second sub-paragraph of the body of the independent claim under consideration. The term "freely slidable" was used in the clause "a second needle extending through

said hollow first needle and freely slidable therewithin." The limitation under consideration did not include "means for" claim language, which would not have been appropriate in such a claim (since an additional structure for such "means" would have been implied, and did not appear to exist or be required.)

In C.R. Bard, one party argued that the term "freely slidable" constituted a claim limitation calling for a particular element (i.e., the "second needle") to be "freely slidable" in both back and forth directions. The opposing party argued that "freely slidable" was a limitation for permitting the second needle to be "freely slidable" in just a forward direction. The Federal Circuit in C.R. Bard ruled that the patent claim before it included the claim limitation that the given element in question had to be "freely slidable" in both directions, which was consistent with the specification and allowed the claim to be patentable over the prior art. The Federal Circuit clearly treated - and found! - that the term "freely slidable" constituted a structural limitation in the claim under review in C.R. Bard.

By the present amendment to independent Claim 20 of the instant patent application (and Claims 21-24 via dependency), Applicant has amended the phrase "capable of freely moving" to --freely movable--, which Applicant respectfully submits is grammatically identical to "capable of freely moving."

The amended phrase --freely movable--, however, is clearly entitled to patentable weight as a structural limitation in Applicant's claims for the identical reason that "freely slidable" was accorded patentable weight in the claims before the Federal Circuit in C.R. Bard. Applicant has been unable to locate any court case or decision from the Board of Patent Appeals & Interferences which would suggest, or logically permit, the phrase --freely movable-- to be denied patentable weight, in view of the Federal Circuit's ruling in C.R. Bard according patentable weight to the term "freely slidable."

Consequently, the Examiner is requested to reconsider the outstanding prior art rejections, and Applicant's arguments concerning the prior art, by according the appropriate patentable weight to the amended term --freely movable--.

5-7 Turning now, in detail, to the Examiner's prior art rejections of Applicant's claims, in the third Office Action the Examiner has rejected Claims 20-22 as being anticipated, pursuant to 35 U.S.C. §102(b), by Chuang, U.S. Patent No. 4,960,022. According to the Examiner, Chuang discloses a plastic film cutter comprising all of the elements recited in the enumerated claims of the rejection, including a freely movable unit that is freely movable along a guide rail (307). The Examiner has expressly refused to accord the phrase "capable of freely moving . . . " any patentable weight.

15 In reply to the Examiner's anticipation rejection apply-

ing Chuang and taking into account the Examiner's rebuttal comments, Applicant has amended the pending claims to now specify that the unit of the invention is "freely movable in both linear and non-linear paths." Chuang, both Applicant and the Examiner would seem to agree, discloses a plastic film, rail-guided cutter. The Examiner maintains that movement along a rail is still "free" movement along the rail, while in a prior Response Applicant took a contrary position. To avoid the issue of whether movement along a rail is nevertheless "free," Applicant does submit that the unit in Chuang is clearly not capable of movement in both linear and non-linear paths. The rail (307) in Chuang is clearly illustrated (e.g., FIG. 3C) as being linear and nothing in either the drawing figures or the textual disclosure of Chuang would suggest use of a rail that was non-linear, nor does Chuang recognize the benefit of a freely moving unit which is also capable of non-linear path movement. The use of a linear rail, in fact, it submitted to clearly teach away from the concept of a cutting unit following a non-linear path for non-linear cutting.

In light of the recitation in Applicant's claims that the unit of the present invention is "freely movable in both linear and non-linear paths," Applicant respectfully submits that the Examiner's 35 U.S.C. §102(b) anticipation rejection of Claims 20-22, which applied Chuang, has been overcome and should now be withdrawn.

Separately, the Examiner has also rejected Claims 20-22 and 24 as being obvious, pursuant to 35 U.S.C. §103(a), over Li, U.S. Patent No. 5,638,603, taken in view of Campbell, Jr., U.S. Patent No. 3,068,569. In this obviousness rejection, it is the Examiner's contention that the primary reference of Li discloses Applicant's invention, substantially as claimed, including upper and lower parts, a gap therebetween, a cutting blade and a blade holder. The Examiner, however, does concede that the Li cutter fails to include means for exerting pressure, as is included in the present Applicant's invention. The Examiner has, therefore, secondarily-applied Campbell, Jr. for its contended teaching of a cutter having means for exerting pressure via a roller (17) disposed immediately in front of a cutting blade (14) for the purpose of placing the sheet material to be cut under tension. The Examiner has, therefore, concluded that it would have been obvious to have provided the device of Li with the means for exerting pressure, as taught by Campbell, Jr., in order to facilitate an enhanced tensioning of the sheet material during cutting. The Examiner has also stated the opinion (which Applicant strongly contends is incorrect) that a claim recitation of an element "capable of" performing a function is not a limitation on the structure recited in that particular claim.

In reply to the Examiner's obviousness rejection applying Li, taken in view of Campbell, Jr., Li is intended for

cutting wrapping off of a roll in a manner which is parallel to an edge thereof. The Abstract of Li makes clear that when the holding part (14) of the wrappage cutter disclosed therein "is pushed forward against a paper to be cut, the paper can be easily and straight cut [sic] in a quick and safe manner." (Li, Abstract, lines 5-7) The "Background of the Invention" in Li further clarifies that the article therein is intended to replace the need for using a ruler to achieve a straight cut of wrapping paper, which is further confirmed in the de-tailed description of Li (Col. 2, lines 62-64), which states that "[n]o ruler is needed in cutting the wrapper paper 3 while the paper can be cut straight and smooth." Further, the two "side parts" in Li, designated by reference numeral "11" therein, make clear that a straight, or linear, cut is all that is intended, and would appear all that is possible, with the cutting device disclosed in Li.

The secondary reference of Campbell, Jr. discloses a letter opener, which invariably cuts open letters, not sheets of paper in a straight, or linear, manner because: (a) the letter itself is invariably linear in form and (b) the groove through which the edge of the envelope to be cut open passes through forces a straight, or linear, cut. (Campbell, Jr., FIG. 2, reference numerals "5" and "6")

The present invention, as now claimed, expressly recites the unit is "freely movable" in both linear and non-linear



paths," which is clearly impossible for an envelope to so move through the opener in Campbell, Jr.

Because both Li and Campbell, Jr. both disclose articles intended for cutting only in a linear path, and neither reference considered separately or in combination with one another suggests any manner of a non-linear cutting path (and, in fact, the construction of each would rule out a non-linear cutting path), Applicant respectfully submits that the present claims, as now amended, cannot reasonably be viewed as being obvious over the proposed combination of art.

Further, Applicant and the undersigned counsel have carefully considered the Examiner's rebuttal to Applicant's contention that the letter opener in Campbell, Jr., is not analogous art to the sheet cutter of the presently claimed invention and, as a matter of record in the file wrapper, must state that they cannot agree with the Examiner's analysis. The Examiner's contention that "[i]t is irrelevant to what degree Campbell Jr. has with respect to Applicant's disclosed invention, since it is the claims that are at issue, not the disclosed invention." The Examiner's statement of the law is not correct.

It is Applicant's disclosure that defines the technical field of the invention, including the intended use of the invention, not simply the claims. While, an intended use for an apparatus is entitled to no "patentable weight" on the

issue of anticipation, the same is not the case where an applicant's claims have been rejected solely on the ground of obviousness over the prior art. See, United States v. Adams, 383 U.S. 39, 148 USPQ 479, 484 (1966) ("This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable innovation. We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness."); 2 Rosenberg, P. D., Patent Law Fundamentals, §9.04 at 9-45 (2d Ed., 1993 rev.) ("Where the claimed structure is simple and/or differs slightly from the prior art, the inquiry may focus upon the utility or result effected.") Consideration of "the utility or result effected" and whether the "utility" or "result" is analogous to that which the prior art is directed, can and, it would seem, must include consideration of the entire disclosure of an applicant's invention. See, especially, In re Chu, 66 F.3d 292, 36 USPQ2d 1089, 1095 (Fed. Cir. 1995), citing, In re Gal, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) ("finding of 'obvious design choice' precluded where the claimed structure and function it performs are different from the prior art"; emphasis added).

Contrary to the view held by many Examiners in the PTO, it is not true that "function" and "intended use" are entitled to "no patentable weight" when evaluating the

patentability of an article or apparatus claim as to the question of obviousness. Quite the opposite! Functionality and utility are vital considerations in rendering obviousness determinations and it is submitted to be difficult, if not impossible, to assess functionality and utility without a full evaluation of an applicant's disclosure, notwithstanding that the patentability examination is that of the claims. Only by a full evaluation of an applicant's disclosure is the scope of the claimed invention attainable and, thus, the scope of analogous and non-analogous prior art.

Applicant therefore respectfully maintains that an article for opening the sides of envelopes is not reasonably related, or analogous, to cutting sheets of paper or other flat material.

The Examiner's statement that various arguments are more relevant to rejections issued under 35 U.S.C. §112, first paragraph, rather than obviousness, is not understood and, in any event, the Examiner is mistaken in his view that "the issue at bar is not in the technical details of the invention nor is it the intended use of the invention per se." The technical details of Applicant's invention is a valid issue, and its intended use, in the context of the law of obviousness, is extremely relevant in defining the relevant technical field and those fields reasonably analogous thereto. Whether or not some of the same issues might also pertain to

the law under 35 U.S.C. §112, first paragraph, is an interesting academic issue, but not of relevance to the validity of Applicant's arguments, or the Examiner's analysis, one way or the other.

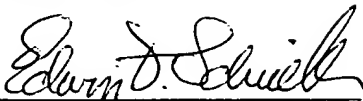
In view of the limitation in Claims 20-24 that the unit of the present invention is capable of cutting in both linear and non-linear paths, which is submitted to be clearly precluded by the devices of the applied prior art references, Applicant respectfully submits that the Examiner should now withdraw the issued 35 U.S.C. §103(a) obviousness rejection, which applies Li, taken in view of Campbell, Jr.

In light of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (i.e., Claims 20-24) recite a novel and efficient apparatus for cutting sheet material able to be used for both linear and non-linear cutting of sheet material, which is patentably distinguishable over the prior art. Accordingly, withdrawal of the outstanding rejections and the allowance of

all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

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- Enc.: 1. Petition for Two-Month Extension;  
2. Check for \$200 (Extension Fee); and,  
3. "Marked-Up" Version of Claim Amendment.

The Commissioner is hereby authorized to charge the Deposit Account of Applicant's Attorney, Account No. 19-0450, for any additional fees which may be due in connection with the prosecution of the present application, but which have not otherwise been provided for.

VERSION OF AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE  
(Dated December 11, 2001)

IN THE CLAIMS

Please amend Claim 20 as follows:

20. (Amended) Apparatus for cutting sheet material,  
comprising:

a unit [capable of freely moving] freely movable in both  
linear and non-linear paths having a lower part defining a  
sheet support surface for placing a piece of sheet material;

an upper part defining an upper surface and disposed  
above said lower part with a gap existing between said upper  
part and said lower part for receiving the piece of sheet  
material;

a cutting blade secured in said upper and lower parts,  
and extending across said gap, said sheet support surface and  
said upper surface extending to either side of said cutting  
blade; and,

pressure means mounted on said upper part in said gap  
for bearing on the piece of sheet material supported by said  
lower part adjacent to said cutting blade, so that the piece  
of sheet material is able to be inserted between said pres-  
sure means and said sheet support surface for tensioning the  
piece of sheet material in proximity of said cutting blade.